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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,244	10/04/2006	Alastair Robert Buckley	BHJ13USA	1726
270 HOWSON & HOWSON LLP 501 OFFICE CENTER DRIVE SUITE 210 FORT WASHINGTON, PA 19034	7590 07/29/2010			
EXAMINER				
MALDONADO, JULIO J				
ART UNIT		PAPER NUMBER		
2823				
NOTIFICATION DATE		DELIVERY MODE		
07/29/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@howsonandhowson.com

Office Action Summary

Application No.

10/550,244

Applicant(s)

BUCKLEY ET AL.

Examiner

JULIO J. MALDONADO

Art Unit

2823

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/200)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____
- Paper No(s)/Mail Date 10/04/2006

DETAILED ACTION

1. Applicants' cancellation of claims 3-15 and 18-32 as set forth in the applicants' reply filed on 09/23/2005 is acknowledged.
2. Claims 1, 2, 16 and 17 are pending in the application.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Aigner ('175).

In reference to claims 1 and 16, Aigner (Figs.1-3) discloses a method of forming a semiconductor device comprising a semiconductor substrate (1) comprising circuitry (17) and terminal means (9) for establishing electrical connection to the circuitry (17); providing a sheet (2) for forming a further layer of the device, the sheet comprising at least one groove (5); applying adhesive to at least one of said substrate (1) and said sheet (5); and aligning said substrate (1) and said sheet (2) in a position such that said at least one groove (5) faces said terminal means (9) and attaching said substrate (1)

and said sheet (2) together by means of said adhesive in said position (Aigner, [0022] – [0024] and [0051] – [0054]).

In reference to claim 17, Aigner discloses wherein the terminal mean comprises a plurality of bond pads (Aigner, see for example, Fig.9, reference character 9).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aigner ('175) as applied to claims 1, 16 and 17 above, and further in view of Ohara et al. (U.S. 5,668,033, hereinafter Ohara).

Aigner discloses applying adhesive to at least one of said substrate and said sheet, but fails to expressly disclose wherein the adhesive is applied solely to said sheet.

However, Ohara (Figs.10-14) discloses a method of manufacturing a packaged semiconductor device including providing a substrate (32); providing a sheet (33) for forming a further layer of the device, the sheet (33) comprising at least one groove; applying an adhesive (24) solely to said sheet (33); and bonding said sheet (33) to said substrate (32) (Ohara, column 6, line 15 – column 8, line 52).

It would have been within the scope of one of ordinary skill in the art to combine the teachings of Aigner and Ohara to enable the disclosed bonding step of Aigner to be performed according to the teachings of Ohara because one of ordinary skill in the art would have been motivated to look to analogous art teaching alternative suitable or useful methods of performing the disclosed bonding step of Aigner and art recognized suitability for an intended purpose has been recognized to be motivation to combine (MPEP 2144.07), and furthermore, because the fact that the claimed combination of elements was "obvious to try" might show that such combination was obvious under 35 U.S.C. §103, since, if there is design need or market pressure to solve problem, and there are finite number of identified, predictable solutions, person of ordinary skill in art has good reason to pursue known options within his or her technical grasp, and if this leads to anticipated success, it is likely product of ordinary skill and common sense, not innovation (KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JULIO J. MALDONADO whose telephone number is (571)272-1864. The examiner can normally be reached on Mon-Fri, 8:00 A.M.-4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Smith can be reached on (571)-272-1907. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Julio J. Maldonado
Primary Examiner
Art Unit 2823

/Julio J. Maldonado/
Primary Examiner, Art Unit 2823